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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,990	03/27/2001	D. Wade Walke	LEX-0152-USA	9270

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LEXICON GENETICS INCORPORATED
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THE WOODLANDS, TX 77381-1160

EXAMINER

SWOPE, SHERIDAN

ART UNIT PAPER NUMBER

1652

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/818,990

Applicant(s)

WALKE ET AL.

Examiner

Sheridan L. Swope

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3 and 6-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

In support of applicants request for withdrawal of the rejection of Claims 1-3 and 6-10 they reiterate their prior arguments and state that the fact that SEQ ID NO: 1 has some homology with the sequences of GenBank Acc # AC024258, AL512429, and AC016395 supports their recited utility for the polynucleotide of SEQ ID NO: 1 in the identification of coding sequences. Said utility is an application which would apply to every member of a general class of materials does not provide a specific and substantial utility for the polynucleotide of SEQ ID NO: 1.

Applicants also argue that the description of their sequences as "structural proteins" and "muscle protein" and a "titin-like protein" supports the function of the presently claimed sequence as a muscle structural protein. Said argument is not persuasive. Knowing that a protein is a muscle structural protein does not provide a specific utility for said protein; no specific cellular processes mediated by said protein or diseases cause by mutation of said protein have been disclosed by the specification. Applicant's recitation on page 2, lines 1-5 of the specification that, "The novel human proteins (NHPs) described for the first time herein share structural similarity with, inter alia, mammalian muscle proteins (myosin light chain kinase, telokin, IgG like C2 domains, motilin), and modifiers and anchors of thereof." Thus, the specification only provides a laundry list of unrelated functions for the recited protein. The fact that another group subsequently demonstrated a function for the protein herein can not be used in hindsight to support one of the many functions recited in the original laundry list.

Thus, the amendment submitted September 2, 2003 only reiterates applicants prior arguments and is not found to be persuasive.

Rebecca Hurst
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